The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN H. WOLFE and NIGEL W. FRASER

Appeal No. 2000-2178
Application 08/393,066

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

The examiner entered an Examiner's Answer on July 25, 1997 (Paper No. 14) which contained a new ground of rejection under 35 U.S.C. § 103. Appellants responded by way of a Reply Brief and an amendment. The examiner first refused to enter the Reply Brief because the amendment to the claims was contained in Appendix II of the Reply Brief instead of a separate paper. Appellants apparently subsequently filed a proper amendment on December 17, 1997, in that the examiner issued a

communication on December 31, 1997 indicating that an amendment filed December 17, 1997 had been entered and the Reply Brief filed September 22, 1997 was also entered. However, the examiner did not state what effect the amendment had on either ground of rejection pending in the case.

Upon return of the application, the examiner needs to take a step back and reassess the patentability of the amended claims. As set forth in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

> If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the examiner continues to believe that the claims are unpatentable she should issue an appropriate Office action setting forth such rejections. It may be that the examiner will need to rely upon additional facts and evidence in support of her conclusion that the amended claims are unpatentable. If so, the examiner will need to reopen prosecution to enter such a rejection as the rules no longer allow an examiner to enter a new ground of rejection during an appeal proceeding under these circumstances. On the other hand, if the examiner believes that the claims are unpatentable on the basis of the existing facts and reasons, we state that we are authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1) for the purpose of the examiner to explain why the amended claims continue to be unpatentable on the basis of the same facts and reasons set forth in the

original Examiner's Answer.

One further point needs to be attended to by the examiner upon return of the application. We have not found the record copy of the amendment filed on December 17, 1997 (Paper No. 17). Rather, what we have found is a facsimile transmission which contains a hand written entry on the first "copy of #17."

Upon return of the application, the examiner should review the file and ensure that all papers are present and properly entered.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Bruce H. Stoner, Jr., Chief
Administrative Patent Judge

Gary V. Harkcom, Vice Chief
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

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